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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/476,384	12/30/1999	DOMINIC JOHN MOREA	06042-0180	7755

7590 10/06/2005
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EXAMINER

OYEBISI, OJO O

ART UNIT PAPER NUMBER

3628

DATE MAILED: 10/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

09/476,384

Applicant(s)

MOREA ET AL.

Examiner

OJO O. OYEBISI

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 90-176 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 90-176 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 8/2/05
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 90-176 stand rejected in this office action. All the features/limitations claimed but not explicitly defined in the specification have been given their broadest possible interpretations.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. **Claims 90-176** are rejected under 35 U.S.C. 102(e) as being anticipated by Kramer et al (Kramer hereinafter, U.S PAT: 6,324,525 B1).

Kramer discloses an online commerce system (Figs. 1-3) including a buyer computer (consumer 186, Figs. 1C, 22), a seller computer (inherent computer(s) at merchant web site, 180; Fig. 22-23), a transaction facilitator (e.g., internet

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transaction gateway, see fig. 21 a/b, merchant web site and related software, 180; Fig. 18A, 27), commercial transactions (Figs. 3, 9, 18A, 20B, 25), displaying branded indicia (not further defined, reads on e.g., the displayed word/icon "John's Wallet", or "Visa", Figs. 32-34; Col. 107), displaying "information" (not further defined, reads on displaying the invoice Figs. 33-34; Col. 102, lines 35-62; or transaction ID, Col. 68; Figs. 20B, 20D, 20E) to the buyer for enabling the buyer to select a payment instrument, the "information" including and displaying selected branding indicia (e.g., Visa, Figs. 32-34) as the selected branding indicia (e.g., Visa, Figs. 32-34) of the transaction facilitator (e.g., internet transaction gateway, see fig. 21a/b, merchant web site and related software, 180; Fig. 18A, 27; merchant also displays and selects Visa, Col. 107, lines 16; URL points to picture of Visa, col. 67, lines 25-49), in response to a proposed transaction the buyer is redirected to payment enabler (e.g., 2845, Fig. 28; Col. 104, lines 24-49), utilizing a payment enabling system (i.e., payment gateway, col.18, lines 29-67, Figs. 27, 31-34; 140, Fig. 1B; 192, Fig. 1C; payment windows and related software, Fig. 1C, Figs. 31-34), receiving transaction details (consumer receives the invoice, Figs. 27, 34; Col. 102, lines 35-62; transaction ID, XID, Col. 120, lines 14-20; transaction data, Figs. 20), displaying invoice for approval (e.g., Fig. 34; Col. 104, lines 24-50), receiving selection of buyers payment method (e.g., Fig. 33-34; or col. 18, lines 49-67), completing transaction (Col. 18, lines 29-67; shipping and handling, col. 15, lines 1-24; merchant gets redirected to request authorization of funds, col. 15, lines 15-34), as specified in claim 90, 101, 113,

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128, 143, 154, 162; co-branding data comprises indicia (e.g., using "Visa", Figs. 32-34; col. 107; merchant web site and related software, 180; Fig. 18A, 21a/b, 27; merchant also displays and selects Visa, col. 107, lines 1-6; URL points to picture of Visa, col. 67, lines 25-49), as specified in claims 91; using Internet (Figs. 21-23; col. 18, lines 36-48; col. 108, lines 22-32), as specified in claims 92, 103, 115, 119, 130, 134, 145, 156, 164; registration page enables buyer or seller (consumer registering, col. 105, line 60-col. 106, line 11; merchant registers, col. 108, lines 22-32), as specified in claims 93, 110, 131, 146, 157, 165, 168; registering prior with static registration (e.g., col. 15, lines 49-59; col. 28, lines 53-64; col. 30, lines 18-36; having credit cards already registered, using a pre-existing account, Fig. 32-34), as specified in claims 94, 105, 117, 121, 132, 136, 147, 158, 166, 170; registering after using dynamic registration (add, or setting up a Visa account on the fly, Fig. 33, col. 45), as specified in claims 95, 106, 118, 122, 133, 137, 148, 159, 167', 171; transaction ID (transaction ID, XID, col. 120, lines 14-20; transaction data, Figs. 20; col. 68, lines 12-36), as specified in claims 96, 108, 123, 138, 149, 172; price, shipping, handling, total price (Fig. 34; col. 15, lines 1-14), as specified in claims 97, 109, 124, 139, 150, 173; sending buyer ID data to payment facilitator (sending consumer's information to be approved, e.g., col. 20, line 340-col. 21, line 20; 2872, Fig. 28; col. 105, lines 6-39), as specified in claims 98, 110, 125, 140, 151, 174; one or more payment instruments (Figs. 33-34; col. 18, lines 49-67; col. 28, lines 51-65; col. 45, lines 16-25; merchant selects, col. 107, lines 1-21; col. 66, lines 63-67; col. 67, lines 24-49), as

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specified in claims 99, 111-113, 126-128, 141-142, 152-153, 160-161, 175, 176; payment processors comprise credit card (Figs. 33-34; col. 18, lines 49-67; col. 28, lines 51-65; col. 45, lines 16-25; merchant selects, col. 107, lines 1-21; col. 66, lines 63-67; col. 67, lines 24-49), as specified in claim 100; displaying selectable distribution by seller (merchant selects, col. 107, lines 1-21; col. 66, lines 63-67; col. 67, lines 24-49), as specified in claims 101, 113, 120, 135, 169; information displayed to the seller comprises a registration page (merchant registers, e.g., col. 108, lines 22-32; merchant selects, col. 107, lines 1-21; col. 66, lines 63-67; col. 67, lines 24-49; check to see if merchant is registered, col. 104, lines 59-67), as specified in claims 104, 120, 135, 169; redirecting the seller to a payment enabler (e.g., when seller goes to obtain authorization, Figs. 3, 9; col. 15, lines 15-25; col. 19, line 15-col. 20, line 32; col. 107, lines 1-22), as specified in claims 128, 154, 113, 101; obtaining approval (Figs. 32-34; col. 104, lines 24-67; authorization, Figs. 3, 9; col. 15, lines 15-25; col. 19, line 15-col. 20, line 32; col. 107, lines 1-22, as specified in claims 107, 113).

Response to Arguments

4. Applicant's arguments filed Aug 2, 2005 have been fully considered but they are not persuasive.
 - In response to the applicant's argument that the examiner has misread and/or misunderstood the nature of the branding indicia that is in the claims as presented. Contrary to the applicant's assertion, there is hardly any detail of what is meant regarding the limitations pertaining to "branding indicia" in the

applicant's specification. Further, the way this limitation is claimed is very broad. The office asserts that any limitations claimed but not explicitly defined in the specification would be given their broadest possible interpretations. Therefore, the previous examiner neither misread nor misunderstood the stated limitation (i.e., branding indicia), he only gave this limitation its broadest possible interpretation.

- Second, the applicant argues that there are no teachings of transaction facilitator in the system of Kramer. However, according to the applicant's disclosure in the specification, the applicant states "the transaction facilitator 230 may be a web site that allows two people to define a desired transaction." The office respectfully asserts that Kramer's internet transaction gateway reads on this limitation (i.e., internet transaction gateway, see col.87, lines 30-65 through col.88, lines 15-35, also see fig. 21 a/b).
- Third, the applicant argues that there is no payment enabler, in the system of Kramer, which handles the payment processing for the transaction facilitator. The applicant states in his specification that a payment enabler computer is typically used to implement the online cash registers, receives a registration of a disbursement instrument for receiving the payment from the buyer. Kramer discloses a payment gateway that reads on limitations stated supra (i.e., The gateway also provides full functionality for merchant payment processing including authorization, capture, settlement, and reconciliation while providing monitor activity with reporting and tracking of transactions

sent over the Internet. Finally, the payment gateway also implements Internet payment procedures that match current processor business models to ensure consistency for merchants, col.18, lines 29-67). The office concurs that these two devices bear different names. However, they perform the same function. Thus, the patentability of an invention is not based on brand/device names, but rather on the novelty of the claimed technological art.

- Lastly, the applicant argues that “branding indicia”, disclosed, is that of the transaction facilitator and not of some payment instruments like VISA. Well, since the applicant fails to explicitly define what the applicant intends to cover by the limitation “branding indicia”, the office has chosen to give this limitation its broadest possible interpretation. The office interprets “branding indicia” to mean different payment instruments of which VISA credit/debit is one type (see Kramer col.28, lines 50-67 through col.28, lines 50-65).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the

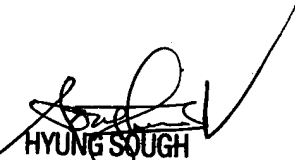
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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to OJO O. OYEBISI whose telephone number is (571) 272-8298. The examiner can normally be reached on 8:30A.M-5:30P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, HYUNG S. SOUGH can be reached on (571)272-6799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


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